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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,082	08/17/2001	Yasushige Nakamura	011040	2870

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,082

Applicant(s)

NAKAMURA ET AL.

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of claims 1-6 (Group I) in Paper No. 5 is again acknowledged. The election has been treated as an election without traverse for the reasons given in the prior Office actions (MPEP § 818.03(a)).

Specification

The amendment filed 15 January 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the changes submitted to Table 2 that introduce external additives and change the infrared absorber are new matter. The specification states that the composition of toners SCY-8 through SCY-14 is as specified in the Tables (p. 26, bottom). There is no other disclosure in the specification to show that the information in the Tables was incorrect. Further, there is no evidence or reasoning provided to show that the changes made are the obvious correction, as would be recognized by the artisan. The changes (except for the insertion of the decimal point in SCY-9, PS-102) are seen as new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. Claim 3 contains the same limitations as now presented in claim

1. Cancellation of claim 3 is suggested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 has been amended to state that the color imaging toner is an electrographic toner which has been fixed on a recording medium. This new limitation is indefinite because once a toner is fixed (e.g., bonded to a receiver such as melting) it is no longer a toner (see spec. p. 2, l. 6-11). A toner is in particulate form (see spec. p. 7, l. 28 - p. 8, l. 4; p. 21, l. 4-12) and, as such, would not be a toner when fixed onto the recording medium because it would no longer be a free flowing particle. The claims are thus indefinite because the limitation on the toner appears to define a structure that is not a toner.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kushino *et al.* in US Patent 6,136,488 in view of Yamanaka *et al.* in US Patent 5,049,467.

This rejection was set forth in the last Office action against the combination of limitations present in claim 1 as amended (note that claim 3 has the same scope of protection as claim 1).

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The rejection is also applicable to claims 4 and 5 because Kushino states the IR absorber is used in an amount of from 0.01 to 5 weight percent (col. 17, l. 15-19) while Yamanaka teaches calixarene charge control agents used in amounts of from 0.1 to 10 parts by weight per 100 parts of the binder resin (col. 3, l. 9-11). Kushino also teaches a preferred wavelength of the IR absorbing agent of between 750 and 1100 nm (col. 2, l. 54-56; col. 4, l. 31-33; col. 6, l. 34-40). The toner is fixed to the receiver in Kushino (Examples; col. 39, l. 8-18).

Applicants traverse this rejection because the calixarene charge control agent-containing toner in Yamanaka is for a heat roll fixing system and not a photo fixing system (response p. 10, bottom). Applicants also note that it is difficult to use both an infrared absorbing agent and a charge control agent in the same toner because of a loss of IR absorbance and charging power due to interactions between the components.

These positions have been carefully considered but are not found persuasive for some of the same reasons given in the last Office action. Specifically, the Examiner agrees that Yamanaka does not disclose the calixarene compound as being effective in a photofixing toner. However, this does not negate the obviousness of combining the references. The charge control agent is used in both Kushino and Yamanaka for the disclosed and expected function of providing necessary triboelectric charge to the toner. This property is important when the electrostatic latent image on the surface of an imaging member is developed. The toner fixing step occurs after the image has been developed (see Kushino col. 39, l. 7-18). There is little or no effect of the charge control agent during the fixing step because the toner has already been attracted to the imaging member. Further, Yamanaka specifically teaches that phthalocyanine colorants are effective in its toner with the charge control agent (col. 8, l. 55 & 56). This indicates that there is not detrimental interaction to charging by combining a compound having a phthalocyanine structure with a calixarene. Further, because the charge control agent in

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Yamanaka is disclosed as colorless there is sufficient reason to believe it would not have significant absorption in at least part of the photofixing range of Kushino.

The fact that Yamanaka's charge control agent is not disclosed in a photofixing process is not material to the expected functions and properties of the charge control agent and is not material to the photofixing step. There is also no requirement in law that the combination rejection state that it obtain the same benefits as the instant invention or be concerned with the same problems as the inventors. As long as there is structural and/or compositional similarity between the references and the art provides a motivation for combination the rejection is properly made.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Takezawa and Katagiri, previously applied, at the time this invention was made. Accordingly, Takezawa and Katagiri are disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
8 March 2004


CHRISTOPHER RODEE
PRIMARY EXAMINER